

REMARKS/ARGUMENTS

Claim 9 was previously canceled. Claims 1-8 have been canceled herewith and re-presented as Claims 11-17, all of which ultimately depend from Claim 10, which was previously presented. Claim 16 now further recited the 20% size decrease, as disclosed at page 10, last line. It is submitted that all claims are fully supported, and entry is requested.

Formal Matters

For the record, there are no objections or rejections under 35USC112 outstanding.

Rejections Under 35 USC 103

Claims 1-8 and 10 stand rejected for reasons of record, including the Response to Arguments appearing at page 2 of the most recent Office Action.

Applicant respectfully traverses the rejections, to the extent they may apply to the claims as presented herewith.

All arguments previously made in support of patentability continue to apply, but will not be repeated here, for the sake of brevity.

In response to those arguments, the most recent Office Action takes the position that the teachings of the WO 97/12955 document would mean that, "...some amount of the non-hydrating material will inevitably be on the outside of the particle, forming a partial coating as recited."

It is respectfully submitted that asserting the inevitability of the coating's being formed in the WO 97 process is tantamount to asserting its inherency.

As recited in the now-amended claims, the coating of the present process must result in the surface area of the finished particle being at least 10% less than the (uncoated) particle core (or, 20% in Claim 16).

Therefore, it must necessarily follow that, for WO 97 to render the present process obvious on the grounds of inherency, the document must provide some teaching relative to the parameter at issue. In this regard, the relevant case law requires that:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 49USPQ2d 1949 (Fed. Cir. 1999). [Emphasis supplied]

It is submitted that the rationale of *Robertson* is on all fours with the present circumstances, wherein the process of WO 97 is not even suggestive of a coating process and

Appl. No. 09/914,527
Atty. Docket No. 7471
Amdt. dated 3/18/2004
Reply to Office Action of 10/27/2003
Customer No. 27752

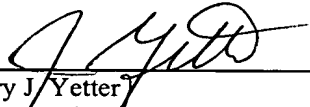
does not employ a coating step. Certainly, nothing therein is suggestive of a coating that leads to a 10% (minimum) decrease in surface area of the final product.

Indeed, it has been held to be improper to establish prior invention when there is an absence of evidence that the alleged prior inventors appreciated at the time of their work all the elements of the invention. *Schering Corp. v. Precision-Cosmet Co. Inc.*, 614 F. Supp. 1368, 227 USPQ 278 (D. Dec. 1985).

In summary, it is submitted that nothing in WO 97 supports a rejection based on inherency ("inevitability") of the coating, as recited by the claims herein. Accordingly, reconsideration and withdrawal of the rejection on this basis are requested.

In light of the foregoing, early and favorable action on the claims now presented is requested.

Respectfully submitted,
Paul R. Mort III

By 
Jerry J. Yetter
Attorney for Applicant(s)
Registration No. 26,598
(513) 627-1907

March 18, 2004
Customer No. 27752
(7471 RCE Response OA 2-3-04.doc)
Revised 10/14/2003